

REMARKS

In response to the Office Action dated October 16, 2003, 2003, claims 4, 9, 22 and 24 are amended. Claims 2-12 and 20-26 are now active in this application. The amendments to claims 4, 9, 22 and 24 are those suggested by the Examiner to address minor clerical errors. No new matter has been added.

The indication that claims 3 and 21-26 are allowable, and that claims 2 and 11 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 12 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Essenpreis et al. (USPN 5,770,454), for the reasons substantially of record.

II. Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Essenpreis et al., as applied to claim 20, in view of Parker (USPN 5,553,613), and further in view of Caro (USPN 5,348,003), for the reasons substantially of record.

III. Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Essenpreis et al., as applied to claim 20, in view of Caro, for the reasons substantially of record.

IV. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Essenpreis et al. in view of Caro, as applied to claim 6, and further in view of Robinson (USPN 5,830,132), for the reasons substantially of record.

V. Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Essenpreis et al., as applied to claim 20, in view of Robinson, for the reasons substantially of record.

VI. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Essenpreis et al., as applied to claim 20, in view of Robinson, and further in view of Anderson et al. (USPN 5,879,294), for the reasons substantially of record.

VII. The rejections under I to VI are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). In imposing a rejection under 35 U.S.C. §102, the Examiner is required to identify wherein a particular reference identically describes each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik*

GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

That burden has not been discharged.

As noted in the previous response, independent claim 20 recites the feature that influence of skin is eliminated by using the luminous fluxes of the different optical path lengths. With this arrangement, influences due to the difference in the content of melanin in the skin and the difference in growth of skin are eliminated. Thereby, accurate measurement is carried out.

In contrast, Essenpreis et al. is silent about this feature. Although Essenpreis et al. illustrates an arrangement provided with a plurality of optical paths and two incident ports 18, 18' (see FIG. 2), Essenpreis et al. does not disclose whether influence of skin (such as difference in the content of melanin in the skin and difference in growth of skin) is eliminated by using the luminous fluxes of the different optical path lengths.

In the present Official Action, the Examiner maintains “Essenpreis discloses a calculator for calculating a bilirubin concentration from the signals received. (column 10, lines 2-8 and column 7, line 65 to column 8, line 29 of Essenpreis et al.). The calculation concentrates on determining bilirubin but also eliminating other influencing factors, such as temperature. (column 4, lines 30-60 of Essenpreis et al.). The elimination of other influencing factors in the final concentration value *is considered to be calculating bilirubin so that influence of skin is cancelled by the luminous fluxes* (emphasis added).”

However, as the Examiner has identified no portion of Essenpreis et al. that discloses or suggests eliminating the influence of skin by using the luminous fluxes of the different optical path lengths, there is no basis for the Examiner to assert that he considers that the elimination of

other influencing factors in the final concentration value is calculating bilirubin so that influence of skin is cancelled by the luminous fluxes. Frankly, such assertion is merely speculation on the part of the Examiner, and does not meet the requirement that the Examiner identify wherein Essenpreis et al. identically describes each feature of the invention recited in claim 20.

Since Essenpreis et al. clearly does not expressly describe calculating bilirubin so that influence of skin is cancelled by the luminous fluxes, the question is whether Essenpreis et al. describe calculating bilirubin so that influence of skin is cancelled by the luminous fluxes under principles of inherency. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

However, for an element/step to be inherent in a reference, the missing element/step *must be necessarily present*, not merely probably or possibly present in the reference. See *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). Since calculating bilirubin itself does not require that influence of skin be cancelled by the luminous fluxes, and since the description, “This allows also to take additional account of other influencing factors (such as the temperature at ht measuring site)” (see column 4, lines 45-47), does not establish that “calculating bilirubin so that influence of skin is cancelled by the luminous fluxes” is necessarily present in Essenpreis et al., the Examiner has not established that “calculating bilirubin so that influence of skin is cancelled by the luminous fluxes” is inherent in Essenpreis et al.

Based upon the foregoing, it can not be said that Essenpreis et al. identically describes the invention recited in independent claim 20 within the meaning of 35 U.S.C. § 102. Consequently,

09/536,762

independent claim 20 is patentable over Essenpreis et al., and the allowance of independent claim 20, as well as claims 4-10 and 12 depending from independent claim 20, is respectfully solicited.

CONCLUSION

Accordingly, it is urged that the application, as now amended, overcomes the rejection of record and is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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